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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|--------------------------|---------------------|------------------|
| 09/482,598 | 01/13/2000 | Terry Michael Bleizeffer | 3000.2.14 | 7219 |

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

ROBINSON, GRETA L.

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2177

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/482,598 | Applicant(s) BLEIZEFFER ET AL. | |
| | Examiner Greta L. Robinson | Art Unit 2177 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-41 are pending in the present application.

Drawings

2. The drawings were received on June 23, 2004. These drawings are acceptable.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "14" and "36" have both been used to designate network. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" (37 CFR 1.121(d)) and include all of the figures

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appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 1, the following limitation is vague and lacks proper antecedent basis: "each group corresponding to one or more application programs" (note claim 1 line 2); "groups not satisfying the user-specified criteria" (note claim 1 lines 8-9). Note the preamble of the claim cites "filtering a plurality of groups of query statements", the examiner suggests including this limitation to clarify the particular group. The term group is used to describe several different elements in the present invention, for example "group listing module" claim 2. Also note independent claims 14 and 28. Claims 2-13, 15-27 and 29-41 are rejected based on dependency.

Regarding claim 3, the following limitation lacks proper antecedent basis: "the group listing" [claim 3 line 3].

Regarding claims 9 and 36, the following limitation lacks proper antecedent basis: "the package identification data" [claim 9 line 1; claim 36 lines 1-2].

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 15, and 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 18, and 35 of U.S. Patent No. 6,539,371 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is well settled that omission of elements and their functions is obvious expedient if the remaining elements perform the same function as before. See *In re Karlson* 136 USPQ 184 (CCPA 1963).. Claims 1, 14 and 28 of the present invention the element "groups query statements" is equivalent to US Patent 6,539,371 B1 use of the term "set of query statements" used in claims 1, 18 and 35.

Claim 1, an "apparatus for filtering a plurality of groups of query statements according to identification data associated therewith, each group corresponding to one or more programs ... a memory device having thereon modules of code for execution by a processor ... at least one filtering module configured to receive one or more user-specified filtering criteria ..." [note: US Patent 6,539,371 B1, **claim 1 lines 1-18**].

Claim 14, a "method for filtering a plurality of groups of query statements ... receiving one or more user-specified filtering criteria ... applying the user-specified criteria to selectively exclude ..." [note: US Patent 6,539,371 **claim 18 lines 1-13**].

Claim 28, an "article of manufacture comprising a program storage medium readable by a processor and embodying one or more instructions executable by the processor to perform a method for filtering a plurality of groups of query statements according to identification data associated therewith ... receiving one or more user-

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specified filtering criteria ... applying the user-specified filtering criteria to selectively exclude ..." [note: US Patent 6,539,371 claim 35 lines 1-16].

Response to Arguments

6. Applicant's arguments with respect to claims 1-41 have been considered but are moot in view of the new ground(s) of rejection. In the response Applicant argued the limitation "at least one filtering module" is configured to "apply the user-specified filtering criteria" in response to the rejection cited under 35 USC 112 second paragraph.

Applicant's arguments regarding the rejection is convincing, however the claim is still vague and a new rejection is cited under 35 USC 112 second paragraph, note citations supra. The examiner cited *In re Karlson* 136 USPQ 184 (CCPA 1963) with respect to a double patenting rejection of the independent claims. Applicant argued that a determination as to the difference in scope and content between the patent claim language and the prior art has not been met with respect to this rejection. Independent claim 1, of the present invention reads: "An apparatus for filtering a plurality of *groups of query statements* according to *identification data* associated therewith" this reads on the language in the preamble of US patent 6,539,371 which reads as follows "An apparatus for filtering a *set of query statements* according to *query explain data* associated therewith". The examiner contends that the limitation "groups of query statements" has the same meaning as the limitation "set of query statements" in the US patent, and that the limitation "query explain data" is equivalent to "identification data". The patented case is more narrow and specific in scope; while the presently claimed invention omits

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elements and functions, note rejection cited under 35 USC 112 second paragraph *supra*. The patented Application claims *two types of specific modules* wherein the system is able to **selectively exclude** query statements. The present invention claims at least one module that performs a selective exclusion or filtering of query statements. The independent claims parallel the limitations of this feature; therefore the examiner respectfully maintains the rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (703) 308-7565. The examiner can normally be reached on Mon.-Fri. 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'G. Robinson', with a stylized flourish extending from the end.

GRETA ROBINSON
PRIMARY EXAMINER
Greta Robinson
Primary Examiner
September 3, 2004